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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,052	07/24/2000	Toshikazu Miyashita	043034/0155	6637
22428	7590	10/22/2003	EXAMINER	
FOLEY AND LARDNER			YUN, EUGENE	
SUITE 500			ART UNIT	PAPER NUMBER
3000 K STREET NW			2682	
WASHINGTON, DC 20007			DATE MAILED: 10/22/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/625,052	MIYASHITA, TOSHIKAZU
Examiner	Art Unit	
Eugene Yun	2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 4 and 12 is/are allowed.
- 6) Claim(s) 1-3,5-11 and 13-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 July 2000 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers et al. (US 6,392,634) in view of Takagi et al. (US 5,251,329).

Referring to Claim 1, Bowers teaches an input apparatus 30 (fig. 2) for inputting information to an information processing device 10 (fig. 1) provided with a display 24 (fig. 1), the input apparatus comprising:

a coupling mechanism 54 and 54a (fig. 2) for detachably coupling the input apparatus to a predetermined portion 58 (fig. 2) formed in the information processing device;

a coordinate information generator for generating coordinate information in accordance with a movement of the input apparatus on a flat surface to control a position of a cursor on the display of the information processing device (see col. 5, lines 23-45); and

a cable for electrically connecting the input apparatus to the information processing device 66 (fig. 2).

Bowers does not teach a battery accommodating portion for accommodating a battery which is used to supply power to the information processing device when the input

apparatus is coupled to the predetermined portion of the portable telephone apparatus by the coupling mechanism. Takagi teaches a battery accommodating portion 15 (fig. 3) for accommodating a battery which is used to supply power to the information processing device 1 (fig. 3) when the input apparatus 23a (fig. 3) is coupled to the predetermined portion of the portable telephone apparatus by the coupling mechanism 18 (fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Takagi to said device of Bowers in order to more sufficiently conserve power in a cellular phone by installing the ringer device in the power supply.

Referring to Claim 2, Takagi also teaches a portable telephone (fig. 3).

Referring to Claim 3, Takagi also teaches an electric contact portion for electrically connecting the battery to the information processing device when the input apparatus is coupled to the predetermined portion of the information processing device by the coupling mechanism (see col. 5, lines 48-61).

Referring to Claim 5, Bowers also teaches the cable being allowed to be pulled out from a rewinding mechanism provided in the information processing device when the input apparatus is removed from the predetermined portion of the information processing device (see col. 4, lines 14-26).

Referring to Claim 7, Bowers also teaches at least two buttons which each functions as right-click and left-click buttons of a mouse when the input apparatus is separated from the predetermined portion of the information processing device 46 (fig. 2) and functions as right cursor key and left cursor key when the input apparatus is

coupled to the predetermined portion of the information processing device by the coupling mechanism 50 (fig. 1).

Referring to Claim 8, Takagi also teaches a keypad including a ten key pad 10d (fig. 3).

3. Claims 9-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers and Takagi in view of Henderson (US 6,035,214) and Constien (US 6,259,932).

Referring to Claim 9, Bowers teaches a portable apparatus comprising:  
a display 24 (fig. 1);  
an input device for inputting coordinate information to the portable apparatus to control a position of a cursor on the display, the coordinate information varying depending on a movement of the input device on a flat surface (see col. 5, lines 23-45);  
and

a coupling mechanism 54 and 54a (fig. 2) for detachably coupling the input device to a predetermined portion 58 (fig. 2) of the information processing device. The combination of Bowers and Takagi does not teach the portable apparatus being a portable telephone apparatus. Henderson teaches the portable apparatus being a portable telephone apparatus (see ABSTRACT). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Henderson to said apparatus of Bowers in order to expand on the features of a portable telephone. The combination of Bowers, Takagi, and Henderson does not

teach coupling the input device to a handset of the portable telephone apparatus. Constien teaches coupling the input device to a handset of the portable telephone apparatus (see figs. 1 and 2 noting that the laptop computer of Bowers can take the form of the device of Constien, which comprises as telephone handset). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Constien to said apparatus of Bowers in order to further expand on the features of a portable phone while maintaining the small size.

Referring to Claim 10, Takagi also teaches a battery accommodating portion 15 (fig. 3) for accommodating a battery that supplies power to the portable telephone apparatus 1 (fig. 3) when the input device 23a (fig. 3) is coupled to the handset of the portable telephone apparatus by the coupling mechanism 18 (fig. 3).

Referring to Claim 11, Takagi also teaches the input device having a first electric contact portion and the handset of the portable telephone apparatus having a second electric contact portion, wherein the first and second electric contact portions are electrically connected to each other when the input device is coupled to the handset by the coupling mechanism (see col. 5, lines 48-61).

Referring to Claim 13, Bowers also teaches said coordinate information transferred from the input device to the information processing device through a cable 66 (fig. 2).

Referring to Claim 14, Bowers also teaches the coordinate information transferred from the input device to the information processing device by wireless (see fig. 6).

Referring to Claim 15, Bowers also teaches the information processing device controlling the input device so that it functions as a keypad of the portable telephone apparatus when the input device is coupled to the predetermined portion by the coupling mechanism (see 50 of fig. 1) and functions as a pointing device when the input device is not coupled to the predetermined portion (see fig. 2).

Referring to Claim 16, Bowers also teaches said input device as a pointing device (see Claim 3 of Bowers).

Referring to Claim 17, Bowers also teaches the pointing device as a mouse having at least a right-click key and a left-click key 46 (fig. 2).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowers and Takagi in view of Ikehara et al. (US 6,400,353).

The combination of Bowers and Takagi does not teach a connector connected to one end of the cable for detachably connecting to the information processing device through the cable. Ikehara teaches connector connected to one end of the cable for detachably connecting to the information processing device through the cable (see the end of cable 7 of fig. 1); and

a cable accommodating space formed in the input apparatus, for accommodating the cable with the connector therein 4 (fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Ikehara to said apparatus of Bowers in order to expand on the features of a portable telephone.

***Allowable Subject Matter***

5. Claims 4 and 12 are allowed.

Regarding Claims 4 and 12, Bowers, Henderson, Ikehara, Constien and Takagi do not teach, alone nor in combination, a secondary battery, which is charged by the battery of the input device when the input device is coupled to the handset of the portable telephone apparatus by the coupling mechanism.

***Response to Arguments***

6. Applicant's arguments filed 8/28/2003 have been fully considered but they are not persuasive.

Regarding Claim 1, while the examiner understands the applicants arguments regarding size, weight and power of the computer and pointing device, there is no size, weight or power restrictions stated in the claim. The examiner does not need to consider the measures stated above if it is not stated in the claim. Furthermore, the claim does not state anything that suggests that the battery accommodating portion has to be a backup battery. The Takagi reference is introduced to show that it is known in the art that an input apparatus, which in the Takagi reference is a microphone, can supply power to an information processing device (which is the telephone 1 in fig. 3) when it is coupled to said information processing device (fig. 2 shows the coupled form).

Regarding Claim 9, the examiner used the combination of the Bowers, Henderson, and Constien reference to reject Claim 9. The only reason the examiner

introduced the Henderson reference is to show that a portable apparatus with an input device comprising a portable telephone is present in the art. Claim 9 does not claim a removable pointing device as the applicant argues that the Henderson does not have. The Bowers reference shows a pointing device coupled to the portable computer. By combining the Constien reference, which shows a portable computer decreased in size to act as a telephone handset, with the Bowers reference, the combination shows that a pointing device can be connected to a telephone handset, even if the handset comprises a portable computer.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2682

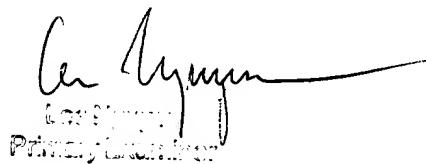
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Eugene Yun  
Examiner  
Art Unit 2682

EY



The image shows a handwritten signature in black ink, which appears to be "Eugene Yun". Below the signature, there is a small, faint printed name "Eugene Yun" followed by the word "PRIMARY EXAMINER" in all caps.